

Application No. 09/520,435
Amendment date 08/23/2005
Reply to Office Communication of 06/23/2005

REMARKS

Reconsideration of the present Application is respectfully requested. No new claims have been added. Claims 1-4, 6-15, and 17-48 are currently pending. Applicants incorporate by reference all of their previous Communications to date.

The Finality of the Office Action of 06/23/05 Is Premature

On 08/02/04, Applicants filed an RCE accompanied with an Amendment, which drew a nonfinal Office Action on 10/13/04. Applicants responded with an Amendment on 11/24/04, that was resubmitted on 02/23/05 because the Office noted that Applicants inadvertently did not properly mark their amendments. The instant Office Action is made final but includes a new ground of rejection, see Office Action 06/23/05, p. 19 and pp. 2-3 citing U.S. No. 6,707,948 to Cosman. The Office Action relies on Cosman to reject independent claims 1, 13, 15, 26, 35, and 45 (that is, each independent claim). The finality is premature for at least two reasons:

- 1) the new ground for rejection was not necessitated by applicants' amendment; and
- 2) newly cited art is used to reject unamended claims.

1) The new ground for rejection was not necessitated by applicants' amendment.

MPEP § 706.07(a) recites:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (emphasis added)

The two conditions above for the exception are met in the instant case. Regarding the first prong, the Examiner introduced Cosman as a new ground of rejection (citations above). But this

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new ground of rejection was not necessitated by Applicants' amendments. In Applicants' last Response we rewrote dependent claims 5 and 16 in independent form (reciting these features verbatim into respective independent claims 1 and 15). Accordingly, the claim scope did not change. That is, the scope of claim 1 has become identical to that of now cancelled claim 5, claim 15 to that of 16. Because the "coordinate transformations" feature was already present in Applicants' last Response, the new ground of rejection could **not** have been **necessitated** by Applicants' amendment. Regarding the second prong, Applicants did not know of and thus did not cite Cosman in an IDS.

2) Newly cited art is used to reject unamended claims.

A second sufficient reason that the finality of the most recent Office Action is premature is because newly cited art is used to reject unamended claims. MPEP § 706.07(a) further recites:

Furthermore, a second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will **not** be made final if it **includes a rejection, on newly cited art**, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17 (p), of **any claim not amended** by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art. (emphasis added)

As mentioned, Applicants did not know of and thus did not cite in an IDS the newly cited Cosman reference. However, it was used to reject claims 9, 10, 20, 24, 25, 29, 32, and 44-48. See Office Action of 06/23/2005, p. 14.

In light of the above, reconsideration and removal of the instant Office Action's finality is respectfully requested.

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Rejections based on 35 U.S.C. § 103

Claims 1-8, 11-19, 21-23, 26-28, 30-31 and 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 6,175,856 issued to Riddle in view of USPN 6,525,830 issued to Yang in further view of USPN 6,707,948 issued to Cosman et al. (hereinafter referred to as Cosman). Applicants respectfully assert that the examiner has failed to make out a *prima facie* case of obviousness with respect to combining Yang with Riddle, and Cosman with Yang and Riddle at least because Riddle is nonanalogous art, the three basic requirements for establishing a *prima facie* case of obviousness have not been established, the proposed modification(s) would render the prior art unsatisfactory for its intended purpose, and the proposed modification(s) would change the principle operation of a reference (e.g., Riddle).

In our previous Amendment, Applicants explained that they were unable to respond to assertions related to Yang because Yang was filed after Applicants' Application, but claimed priority from a CIP. Without the Parent Application available, Applicants could not determine whether Yang was a proper citable reference. Having been provided copies of the Parent Application, Applicants can now substantively respond to the Office's assertions related to Yang.

1) Riddle is nonanalogous art. MPEP 2141.01(a).

With the pending claims having been amended, and a 103 rejection now pending against all of them, Applicants respectfully assert that Riddle is nonanalogous art. A *prima facie* case of obviousness cannot be maintained when the references are nonanalogous art. MPEP § 2141.01(a). To rely on a reference as a basis for rejection, the reference must either:

1A) be in the field of applicant's endeavor or, if not,

1B) be reasonably pertinent to the particular problem with which the inventor was concerned.

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MPEP § 2141.01(a) citing *In re Oetiker*, 977 F.2d 1443, 1446 24 U.S.P.Q. 2d 1443, 1445 (Fed. Cir. 1992).

1A) Riddle is not in the field of Applicants' endeavor.

Riddle discloses a teleconferencing system where communication is facilitated between a sending system and a receiving system (Abstract, FIGS. 1-2, col. 1, line 57 - col. 2, line 49). The two systems pair sending and receiving codecs (coder/decoders) to communicate data according to a determined compression scheme. A receiving device provides a list of available decompressors to a sending device. Col. 9, lines 40-46. The sending device then selects the best decompressor from the list, even if it is the "worst" codec, to communicate data in a compressed format. Col. 10, lines 39-45. Riddle is directed to providing an improved method and system for establishing teleconferencing calls. Riddle communicates between two computers, such as Macintosh computers.

In contrast, Applicants' claimed invention relates to a method for transferring a compressed file to a peripheral device such as a printer to be printed. Communicating between two computers, such as Macintosh computers, is far different than communicating between a software application and a peripheral device.

1B) Riddle is not reasonably pertinent to the particular problem with which the inventor is concerned.

Applicants are concerned with providing a compressed data-file-transfer structure and method in which the compressed files are transferred to a hardware device without uncompressing the file. But Riddle is concerned with teleconferencing applications between computers. Even Riddle's title is telling: "Method and apparatus for dynamic selection of compression processing during teleconference call initiation." No one of ordinary skill in the art at the time of Applicants' invention would "logically have commended" his attention to Riddle's

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disclosure to learn how to develop and improve a method of printing using image passthrough extensions. *See Applicants' title.* The above is presented in summary fashion so as to not obscure our arguments.

Applicants note that all three references are in different U.S. classifications: Riddle 709/204, "COMPUTER CONFERENCING;" Yang 358/1.1, "FACSIMILE AND STATIC PRESENTATION PROCESSING"; and Cosman 382/240, "IMAGE COMPRESSION OR CODING - Pyramid, hierarchy, or tree structure." Applicants note that such is not dispositive but is at least some evidence of nonanalogy. MPEP § 2141.01(a), 2nd bold heading.

For these reasons, Riddle is unavailable as a prior-art reference. Because Riddle is relied upon by the Office to reject every pending claim, each is allowable at least because Riddle is nonanalogous art.

2) The three basic requirements for establishing a *prima facie* case of obviousness have not been established. MPEP 2143.

The requirements of a *prima facie* case of obviousness are summarized in MPEP § 2143 through § 2143.03. In order "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991)." *See* MPEP § 2143. Further, in establishing a *prima facie* case of obviousness, the initial burden is placed on the Examiner. "To support the conclusion that the

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claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972, 972, (Bd. Pat App. & Inter. 1985)." *Id.* See also MPEP § 706.02(j) and § 2142.

2A) There must be some suggestion or motivation to modify the reference or to combine reference teachings.

This first prong of the test set forth in § 2143 cannot be met. There must be some suggestion or motivation to modify the reference or to combine reference teachings. Here, there is neither. The Office Action concedes that Riddle does not teach the device being a printer. See for example the Office Action of 06/23/05, p. 3. It states that "Yang teaches transferring a data to a printer to be compressed and decompressed (abstract; col. 2, lines 9-15). At the time that invention was made, it would have been obvious to one of ordinary skill in the art to employ a printer as said device in order to facilitate the transferring of the compressed data file, therefore improving printing speed (col. 2, lines 9-15)." Applicants respectfully disagree. There are three possible sources for a motivation to combining references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.

Nature of the problem to be solved. We have described above how Riddle is a problem that is far different from that addressed by Applicants.

Teachings of the prior art. There is certainly no teaching in Riddle to much of anything, if anything at all, related to printing. Riddle doesn't even mention the word "print" or "printing". How can there be any teaching in Riddle to, in any way, modify it according to Yang to achieve a result that is the subject of Applicants' invention? And how would it be so modified? The Office Action states "improving print speed" as a potential factor that would

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motivate somehow combining Yang with Riddle. But again, Riddle is not concerned at all with improving print speed. There are no teachings in Riddle or Yang to modify Riddle accordingly.

The knowledge of persons of ordinary skill in the art. This is an interesting point. The pertinent art of Applicants' invention is a method and structure for processing compressed data image files utilizing image passthrough extensions, and principally printing. See Applicants' Specification, p. 1, ll. 3-5. That person would not look to Riddle's area of improving teleconference calls. And a person who is concerned with improving the quality of teleconference calls would not be motivated to look to a reference such as the Yang reference, which is specifically concerned with improving printing speed. See Yang's Title and Summary.

Accordingly, there is no suggestion or motivation to modify Riddle or to combine Riddle's teachings with that of Yang or of Cosman. In the past, the Office did not respond to an argument asserting lack of combinability of references but only restated the applicable standard that a teaching or motivation is required; rather than providing facts to support the assertion that the references are combinable. See Office Action of 02/05/04, pp. 17-18.

With no such suggestion to either modify the reference or to combine the teachings, a *prima facie* case cannot be made. As such, the Application is in condition for allowance.

2B) There must be a reasonable expectation of success.

This second requirement to properly establish a *prima facie* case of obviousness set forth in § 2143.02 also cannot be met. At least some degree of predictability is required. But there is no way any teaching in Riddle or Yang contemplates a successful combination of the two because the two are in such disparate fields that there is no reasonable way that they could even be combined.

2C) The prior-art references must teach or suggest all the claim limitations.

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Applicants comment on this third prong for completeness and do not intend to diminish the weight of the arguments above. Not only is there no suggestion or motivation to modify Riddle in view of Yang and even Cosman, even if they were combined, all of Applicants' features would not be taught by the combination. MPEP § 2143.03.

Each independent claim recites a "performing coordinate transformations" feature. The Office Action cites to Cosman's abstract and col. 13, ll. 17-28 for teaching this feature. See Office Action of 06/23/05, p. 3. But neither Cosman's abstract nor the cited column teach what Applicants actually claim "performing coordinate transformations." The passage does use the term "coordinate," but in a different context, and falls short of actually teaching "performing coordinate transformations."

For example, claim 2 recites "the data structure containing an indication of a classification of the compressed data file format and a pointer to the compressed data file." Although the Office Action of 06/23/05, cites to Riddle's col. 9, ll. 40-66 for teaching this feature, it does not. Riddle makes absolutely no mention of pointers to files at all.

Regarding claim 3, the Office Action of 06/23/05, on p. 4 cites to Riddle's abstract and other citations for teaching "determining whether the file decompression configuration data structure indicates whether the printer is configured to decompress the compressed data file." But those citations do not teach the determination step. And Yang does not teach the determination step either.

By way of further example, claim 4 recites "passing a compressed data file pointer to the printer device; and receiving an indication whether the peripheral device is configured to decompress the compressed data file." A pointer can act as a referential file identifier that is smaller in size than the file to which it refers. Applicants' claimed invention

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takes advantage of this and other beneficial characteristics associated with pointers. Riddle, however, communicates data without the use of pointers and offers no suggestion to use pointers. Although Applicants have asserted this argument before (see Amendment of 11/10/03, p. 16), the Office replied that “[c]laims 2-12, 14 and 46-53 depend on rejected independent claims, therefore are not patentable.” See Office Action of 02/05/04, p. 19. This statement is overreaching, because although some claims may be objectionable, they are not inherently unpatentable especially because they generally include additional features that render them patentable. The Office has not yet responded to this argument.

By way of further example, dependent claim 10 is separately patentable over Riddle. Claim 10 recites “receiving an *uncompressed* data file from the software application if the printer device is not configured to receive the compressed data file.” Riddle, in contrast, teaches to search for a better sending compressor but to send the compressed file even if a poor decoder at the receiving end will be used (col. 10, lines 46-52). Riddle does not teach offering an alternative to uncompress the file. The Riddle process always sends the file in a compressed format. The Office has not yet responded to this argument.

All of the features of the independent claims are not taught either alone or in combination. As such, they are allowable, and so too are their corresponding dependent claims by virtue of their dependence.

3) The proposed modification(s) would render the prior art unsatisfactory for its intended purpose. MPEP 2143.01, 5th bold heading.

This argument actually goes to the “some suggestion or motivation” to combine the first prong of the *prima facie*-case-of obviousness analysis but is sectioned here for easier reading. Modifying Riddle in light of Yang would render Riddle unsatisfactory for its purpose; and as such, there can be no suggestion or motivation to make any such modification, and a

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prima facie case of obviousness cannot be maintained. See MPEP § 2143.01 [R-2], 5th bold heading "The proposed modification cannot render the prior art unsatisfactory for its intended purpose," pp. 2100-131, 2100-1. Although Applicants know of no way to actually modify Riddle to incorporate the teachings of Yang, if such modification were made, then Riddle would become reduced to a method for printing, rendering it unsatisfactory for its intended purpose of improving teleconferencing between two geographically distinct computers. Again, Riddle makes absolutely no mention of even the word "printer" or "print."

4) The proposed modification(s) would change the principle operation of a reference (e.g., Riddle). MPEP 2143.01, 6th bold heading.

This section also goes to the "some suggestion or motivation" to combine the first prong of the *prima facie*-case-of obviousness analysis, but is sectioned here for easier reading. Applicants respectfully submit that there is no suggestion or motivation to modify the Riddle reference with the Yang reference because the modification would change the principle of operation of the system in the Riddle reference. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959)." MPEP § 2143.01. The principle of the operation of Riddle is to facilitate a teleconference call, which is inherently bidirectional (both parties want to be able to talk to the other). But the bidirectional nature of a teleconference call would be lost if Riddle were reduced to a method for remotely printing.

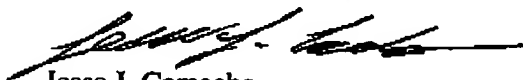
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CONCLUSION

No fee is believed due in connection with this Amendment. The finality of the outstanding Office Action is premature, and removal of the same is respectfully requested per MPEP § 706.07(d). The instant Application is in condition for allowance because the references are not properly combinable with each other, and because even if they somehow were combined, they still would not teach all of the features of the claimed invention.

Although no fee is believed due in connection with this Response, the Commissioner is hereby authorized to charge any additional amount required or credit any overpayment to Deposit Account No. 19-2112.

Respectfully submitted,



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